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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/668,670

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Mark C. Nicely

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29159 7590 09/14/2007  
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EXAMINER

SAGER, MARK ALAN

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

09/14/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

<b>Office Action Summary</b>	Application No. 10/668,670	Applicant(s) NICELY ET AL.	
	Examiner M. A. Sager	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-23, 25-27, 29-54 and 56-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-23, 25-27, 29-54 and 56-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Claim Interpretation***

1. The invention defined by claim language regarding first, second and/or third wager or streak round (or similar) fails to preclude wagers by multiple players/bettors over successive or simultaneous rounds of play at least due to a plurality or multiple players includes a player or stated in the alternative comprising a player fails to preclude multiple or a plurality of players due to open-ended of comprising. Further, currently only claims 7-8, 21-23, 25-27, 29-38, 45-46 and 57 appear to require a plurality [first and second (or third)] of side wagers to be concurrent; however, cited claims fail to preclude wagers from multiple parties at least since comprising a player fails to preclude multiple players or stated differently a plurality of players includes a player and present claim language includes tracking of a plurality of players and does not limit to only a single player. Also, claim language does not require first and second (or third) side wager being differentiated. The broadest reasonable interpretation of claimed method or apparatus is a counter or mechanism for counting or displaying status of consecutive events.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the display device (clm 22) in combination with a representation being printed on a table or covering (clm 29) or being a three dimension structure (clm 30), and chart, pie chart (clms 34, 36) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being

Art Unit: 3714

amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Amended claim 38 states in part "An comprising" and thus lacks defining a preamble subject matter; however, for purposes of examination, it is deemed --An apparatus--.

***Claim Rejections - 35 USC § 102***

5. Claims 1-13, 16-18 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Orenstein ('431). This holding is maintained for cited claims, as amended, from prior action that is reiterated herein with due consideration of amended language and broadest reasonable interpretation thereof. Response to Applicants assertion of patentability is provided below and

Art Unit: 3714

incorporated herein. Claim interpretation cited above is incorporated herein. Orenstein discloses a system and method to manually record, track and monitor progress of multiple consecutive wins for each of a plurality of players at/on a table game (abstract, 1:59-2:62, 3:15-4:67, 5:28-6:37, figs. 1-6) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager from a player (abstract, 1:59-2:62, 4:13-67, 5:28-6:37, figs. 1-6), receiving an outcome and determining whether outcome is same as selected type for first and second streak round (abstract, 1:59-2:62, 4:13-67, 5:28-6:37, figs. 1-6), tracking the number of received consecutive outcomes that are identical to elected type of outcomes for first and second streak (abstract, 1:59-2:62, 4:13-67, 5:28-6:37, figs. 1-6), where first, second and third wager/streak are representative of first, second and third players wagers which can be simultaneous during main rounds of play since players may place proposition [such as streak wager] bets prior to start of any game or first, second and third wager/streak are representative of a wager from a single player at differing subsequent [not simultaneous] rounds of play. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not

Art Unit: 3714

what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Orenstein ‘431 discloses an apparatus (fig 1-6) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (sic, esp. fig. 2-3e) teaching all claimed structure.

6. Claims 1-13, 15-18, 20-23, 25-27, 38-51, 53-54 and 56-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Orenstein (‘885 or ‘574). At outset, for clarity of record, the office notes typographical error in header of paragraph 7 of prior action regarding claim 16 rather than 15 such that electronic display was clearly taught by Orenstein and claim 28 similarly claiming electronic display was also rejected. Typographical error was inadvertent, and electronic display was treated within prior holding and thus is not a new issue herein. This holding is maintained for cited claims, as amended, from prior action that is reiterated herein with due consideration of amended language and broadest reasonable interpretation thereof. Response to Applicants assertion of patentability is provided below and incorporated herein. Claim interpretation cited above is incorporated herein. Orenstein ‘574 incorporates Orenstein ‘885 by reference thus discussion follows from Orenstein ‘885; however, other citations may apply. Orenstein ‘885 discloses a system and method to electronically record, track and monitor progress of multiple consecutive wins for each of a plurality of players at/on a table game or electronic game apparatus (abstract, 1:43-2:47, 3:18-6:61, figs. 1-8) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager from a player (abstract, 1:43-2:47, figs. 1-8), receiving an outcome and determining

Art Unit: 3714

whether outcome is same as selected type for first and second streak round (abstract, 1:43-2:47, figs. 1-8), tracking the number of received consecutive outcomes that are same as selected type of outcomes for first and second streak (abstract, 1:43-2:47, figs. 1-8), where first, second and third wager/streak are representative of first, second and third players wagers which can be simultaneous during main rounds of play since players may place proposition [such as streak wager] bets prior to start of any game or first, second and third wager/streak are representative of a wager from a single player at differing subsequent [not simultaneous] rounds of play. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Orenstein '885 discloses an apparatus (fig 1-8) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (sic, esp. fig. 1-8, ref 15, 46, 76) teaching all claimed structure.

7. Claims 1-4, 6-10, 12-13, 15-18, 20-23, 25-27, 29-33, 37-42, 44-48, 50-51, 53-54 and 56-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Forte (5586766). This holding is

Art Unit: 3714

maintained for cited claims, as amended, from prior action that is reiterated herein with due consideration of amended language and broadest reasonable interpretation thereof. Response to Applicants assertion of patentability is provided below and incorporated herein. Forte discloses a system and method to electronically record, track and monitor progress of multiple consecutive wins for each of a plurality of players at/on a table game or electronic game apparatus (abstract, 3:65-16:36, figs. 1-21) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620), receiving an outcome and determining whether outcome is same as selected type for first and second streak round (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620), tracking the number of received consecutive outcomes that are same as selected type of outcomes for first and second streak (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620), where first, second and third wager/streak are representative of first, second and third players wagers which can be simultaneous during main rounds of play since players may place proposition [such as streak wager] bets prior to start of any game. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29



Art Unit: 3714

(CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Forte discloses an apparatus (fig 1-21) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (abstract, figs. 1-21, refs. 20, 22, 24, 40, 42, 44, 211-216, 451-456, 459, 620) teaching all claimed structure.

8. Claims 1-13, 15-18, 20-23, 25-27, 30-32, 34-35, 37-51, 53-54 and 56-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Feinberg (5851010). This holding is maintained for cited claims, as amended, from prior action that is reiterated herein with due consideration of amended language and broadest reasonable interpretation thereof. Response to Applicants assertion of patentability is provided below and incorporated herein. Claim interpretation cited above is incorporated herein. Feinberg discloses a system and method to electronically record, track and monitor progress of multiple consecutive wins for each of a plurality of players at/on a table game or electronic game apparatus (abstract, 1:27-41, 2:31-8:49, figs. 1-4) teaching all claimed steps/features including receiving first and second (and third) streak wager on first and second (and third) streak round and displaying a representation of first and second (and third) streak wager from a player (abstract, 3:23-35, fig. 1), receiving an outcome (fig. 1, block 40) and determining whether outcome is same as selected type for first and second streak round (abstract, fig. 1), tracking the number of received consecutive outcomes that are same as selected type of outcomes for first and second streak (abstract, fig. 1-4), where first, second and third wager/streak are representative of first, second and third player wagers which can be

Art Unit: 3714

simultaneous during main rounds of play since players may place proposition [such as streak wager] bets prior to start of any game or first, second and third wager/streak are representative of a wager from a single player at differing subsequent [not simultaneous] rounds of play. Further, with respect to claimed apparatus, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, Feinberg discloses an apparatus (fig 1-4) for wagering comprising a display that include positions into which a representation of a wager is moved to indicate progress in a streak round (abstract, figs. 1-4) teaching all claimed structure.

### ***Claim Rejections - 35 USC § 103***

9. Claims 14, 34-35 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinberg. Feinberg discloses invention including tracking consecutive [streak] events (figs 1-4) on a game table (figs. 1-4, esp. 1 and 3) or by gaming machine that would be done electronically or electromechanically (fig. 1 and 3) which clearly fig 3 depicts a graphical image of progress, but does not particularly describe a graph or bar graph as claimed. Although the representation

Art Unit: 3714

of progress of consecutive events taught by Feinberg is not a graph or bar graph, as claimed, the display taught by Feinberg provides progress of consecutive events such as streak rounds of claimed invention in that the claimed graph or bar graph fails to patentably distinguish. A graph or bar graph provides an easy visual indication and thus would be obvious to add to Feinberg so as to provide an easy visual indication of state of game including illustration of progress of streak round/wager.

10. Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinberg. Feinberg lacks chart and pie chart. Although the representation of progress of consecutive events taught by Feinberg is not a chart or pie chart, as claimed, the display taught by Feinberg provides progress of consecutive events such as streak rounds of claimed invention in that the claimed chart or pie chart fails to patentably distinguish. A chart or pie chart provides an easy visual indication and thus would be obvious to add to Feinberg so as to provide an easy visual indication of state of game including illustration of progress of streak round/wager.

#### ***Response to Arguments***

11. Applicant's arguments filed 6/26/07 have been fully considered but they are not persuasive. In response to Applicants argument(s) regarding patentability, the examiner disagrees that present claimed invention is limited to a single player. Although the claims may include a single player, as stated above, present claim language fails to preclude multiple players placing a side wager as rendering claimed invention taught by cited art at least due to failing to require only a player and failing to differentiate first and second (or third) side wagers as wagering on separate wagering aspects. Also, this is not a statement or admission that claiming only a player or differentiating first from second side wager as wagering on differing aspects

Art Unit: 3714

defines patentable matter, but rather is clarifying how breadth of present claimed invention is taught by cited references. Further, the different references are applied due to different forms of presentation [display] and tracking [manual, electronic, electro-mechanical] that appear to be included by present claimed invention. Further, it is reiterated as cited in holdings above that claiming the manner of use [single player placing side wager(s)] of structure fails to patentably distinguish over references teaching the structure; especially, in light that claimed structure cannot differentiate who is using.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

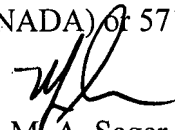
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

Art Unit: 3714

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



M. A. Sager  
Primary Examiner  
Art Unit 3714

mas